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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,012

08/11/2006

Tatiana A. Egorova-Zachernyuk

Q92604

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23373 7590 03/26/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

BARNHART, LORA ELIZABETH

ART UNIT

PAPER NUMBER

1651

NOTIFICATION DATE

DELIVERY MODE

03/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary	Application No.	Applicant(s)	
	10/564,012	EGOROVA-ZACHERNYUK, TATIANA A.	
	Examiner	Art Unit	
	Lora E. Barnhart	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 31,32 and 36-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendments

Applicant's amendments filed 12/23/09 to claim 13 have been entered. Claims 1-12 and 16 have been canceled in this reply. Claims 31-40 have been added. Claims 13-15 and 31-40 remain pending in the current application, of which claims 13-15 and 31-40 are being considered on their merits. Claims 17-30 remain withdrawn from consideration at this time. References not included with this Office action can be found in a prior action. Any rejections of record not particularly addressed below are withdrawn in light of the claim amendments and applicant's comments.

Currently amended claim 13 is directed in part to an invention that is independent or distinct from the invention originally claimed for the following reasons: It includes an embodiment in which the biomolecule is "a molecule that is naturally synthesized by the mammalian or insect cells." Had the original claims included such a limitation, the examiner would have imposed a species election, because all biomolecules are not functional equivalents for each other. For example, glucose is a biomolecule, but it has a completely different structure and function than a protein. See PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(I)(B)(2). Since applicant has received an action on the merits for the originally presented invention, *i.e.*, a method in which the biomolecule is a protein, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 will be examined to the extent that it reads on an embodiment in which the biomolecule is a protein. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendments to the claims introduce claims with numerous non-equivalent species. Had these Markush-type claims been included in the original claim listing, the examiner would have imposed a species election. Accordingly, the examiner has determined that such a requirement is proper here. Many of the new claims (e.g., claims 32 and 36-39) correspond to original claims that were originally subject to a species election (e.g., claims 2, 3, 8-11, and 26). Applicant could have obviated the below requirement by indicating within the 12/23/09 reply which species in the new claims should have been examined. Applicant acknowledged in that reply that the new claims correspond to now-canceled original claims 2-12, which were subject to a species election in the original restriction requirement mailed 1/15/09.

Election/Restrictions

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Organisms grown: Numerous, as in claim 32; elect ONE. Claim 31 will be examined to the extent it is commensurate in scope with this election.

Source of lipids: Numerous, as in claim 36; elect ONE.

Source of amino acid hydrolysate: Numerous, as in claim 38; elect ONE. Claim 37 will be examined to the extent it is commensurate in scope with this election.

Further components: Numerous, as in claims 39; elect ONE particular component or combination of components from the list of components in this claim.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply

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must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: Claims 13-15, 33, 34, and 40.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Pursuant to PCT Rule 13.2 and PCT Administrative Instructions, Annex B, Part 1(f)(I)(B)(2), the species are not art-recognized equivalents. When alternatives of chemical compounds are claimed, they shall be regarded as being of a similar nature where all alternatives have a common property or activity, and either a significant structural element is shared by all of the alternatives, or all of the alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains. The words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of

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existing prior art, and the common structure is essential to the common property or activity. The structural element may be a single component or a combination of individual components linked together. The words "recognized class of chemical compounds" mean that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

In this case, the organisms in claims 31, 32, and 36-38 represent different species of organisms that are not art-accepted equivalents. For example, *Pichia* and *Saccharomyces* are yeasts, while *Porphyridium* is a red alga. The components in claim 39 are not art-accepted equivalents for each other. For example, glucose is a sugar while pyruvate is an alpha-keto acid.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is (571)272-1928. The examiner can normally be reached on Monday-Thursday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lora E Barnhart/
Primary Examiner, Art Unit 1651